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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,358	06/30/2004	Aki Kobayashi	042276	2290

38834 7590 06/21/2007  
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WASHINGTON, DC 20036

EXAMINER
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CHONG, YONG SOO

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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06/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/500,358

Applicant(s)

KOBAYASHI ET AL.

Examiner

Yong S. Chong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Application***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/24/2007 has been entered.

Claim(s) 1-18 are pending. Claim(s) 13-18 have been withdrawn. Claim(s) 1-12 are examined herein.

Applicant's arguments have been fully considered but found not persuasive. The rejection(s) of the last Office Action are maintained for reasons of record and repeated below for Applicant's convenience.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being obvious over Clarkson et al. (US Patent Application 2001/0036964 A1) in view of McCue et al. (US Patent 5,403,587).

The instant claims are directed to a cosmetic or medicinal composition comprising 1,2-alkanediols and one or more materials selected from the group consisting of citronellal, terpinyl acetate, citronellol, and  $\beta$ -pinene.

Clarkson et al. teach an anti-microbial composition comprising polyhydric alcohol (abstract), where the preferred compounds are 1,2-hexanediol and 1,2-octanediol (section 0065). This composition is concerned with reducing microbial numbers upon the surface of the human body such as underarm or feet, thereby reducing malodor (section 0001), therefore requiring the use of perfumes or fragrances (section 0086). When used on the surface of the skin to fight micro-organisms, the invention is formulated into deodorants (section 0002). In this manner, this composition disclosed by Clarkson et al. reads on both a cosmetic or medicinal composition.

Clarkson et al. teach polyhydric alcohols such as 1,2-hexanediol and 1,2-octanediol, therefore it is obvious to use homologs of those compounds for the same purpose. It is well settled in patent law that the selection of a known material based on its suitability for its intended use is prima facie obvious. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). What's more, the prima facie

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obviousness is also supported by the holding that homologs are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

Examiner notes that in the absence in the specification as to what exactly is the scope of a "cosmetically and medicinally effective agent," the claims will be interpreted broadly so that the active agent disclosed by Clarkson et al. will read on a "cosmetically and medicinally effective agent."

However, Clarkson et al. fail to teach citronella, terpinyl acetate, citronellol, or  $\beta$ -pinene in the composition.

McCue et al. teach that citronella (col. 1, line 59), which is a source of citronellal, is a well-known antiseptic compound (col. 1, lines 44-46) and is utilized for its antimicrobial activity (col. 1, lines 8-9).

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to combine the antimicrobial compositions taught by Clarkson and McCue et al. with each other.

A person of ordinary skill in the art would have been motivated to make this combination because: (1) both Clarkson and McCue et al. disclose antimicrobial compositions and (2) of the reasonable expectancy of successfully producing an effective cosmetic and/or medicinal composition.

"It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... The idea of combining them flows logically from their

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having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being obvious over Clarkson et al. (US Patent Application 2001/0036964 A1) and McCue et al. (US Patent 5,403,587) as applied to claims 1-9 in view of Jensen et al. (US Patent 2,550,255).

The instant claims are directed to a food composition comprising 1,2-alkanediols and one or more materials selected from the group consisting of citronellal, terpinyl acetate, citronellol, and  $\beta$ -pinene.

Clarkson and McCue et al. teach as discussed above, however fail to disclose specifically a food product containing this composition.

Examiner notes that in the absence in the specification as to what exactly is the scope of a "nutritionally effective edible substance," the claims will be interpreted broadly so that the active agent disclosed by Clarkson et al. will read on a "nutritionally effective edible substance."

Jensen et al. teach anti-bacterial agents to be employed as an effective preservative for food products (col. 1, lines 34-56).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use the antimicrobial composition as taught by Clarkson and McCue et al. in food products.

A person of ordinary skill in the art would have been motivated to use the composition taught by Clarkson and McCue et al. in food products because the anti-

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bacterial properties of 1,2-hexanediol and 1,2-octanediol can be used as a preservatives in food products to prevent spoilage and decomposition.

***Response to Arguments***

Applicant argues that the Clarkson or Pan et al. provides no teaching or suggestion to use the compounds in the present invention in any food or edible substance.

In response to applicant's arguments against the references, one cannot show nonobviousness by attacking references individually where the rejections are based on the combination of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Examiner reminds Applicant that the standard for an obviousness rejection is not absolute but a reasonable expectation of success. In the present case, Jensen clearly teaches that some anti-bacterial agents may be used with food, as admitted by the Applicants. Although there are millions of other antibacterial agents, one of ordinary skill in the art would have had a reasonable expectation of success in preserving food by adding an antibacterial agent.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Okada Declaration under 37 CFR 1.132 filed 2/23/2007 is insufficient to overcome the rejection of claims 1-12 based upon Clarkson, McCue, and Jensen et al. as set forth in the last Office action. At the outset, the Declaration is not commensurate with the scope of the claims, since the only synergistic data present is between thymol and 1,2-octanediol, which has been previously cancelled from the claims. Therefore, the Applicant has not provided synergistic raw data within the scope of the present claims.

Furthermore, Applicant has attempted to provide side-by-side comparison with the closest prior art. Again, the Declaration is not commensurate with the scope of the claims, since Applicant has only provided a single data point as it pertains to 1,2-octanediol.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax

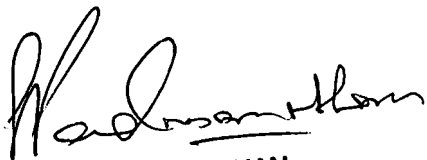


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phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER